IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: GOKHALE ET AL.	EXAMINER: SUSAN Y CHEN
APPLICATION NO.: 09/991,900	ART UNIT: 2161
FILED: NOVEMBER 23, 2001	CONF. NO: 3389
FOR: METHOD AND SYSTEM FOR SCHEDULING MEDIA EXPORTS	

Reply Brief Under 37 C.F.R. § 41.41

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief responds to the Examiner's Answer ("Answer") mailed July 17, 2007 in the above-identified application. The appellants respectfully assert that the Answer is premised on an incorrect application of the law regarding obviousness and a mischaracterization of the appellant's earlier arguments. This Reply Brief accordingly addresses each of the errors in the Answer.

The appellants' claimed embodiments attempt to solve, among other things, problems with providing a media library with resources available to receive data from storage devices. The appellants' claimed embodiments solve these problems, in addition to providing other benefits, by scheduling a time of export for media identified for export, and then exporting the media at the later scheduled time.

For example, when a typical data backup system (at the time the application was filed) is finished with a piece of media (e.g. a tape), the system sends a signal to a media library to cause the library to immediately grab the used tape (e.g., via a robotic arm within the library) and place the tape in a

removal area, such as in an export bin. Then, a library administrator takes the tape from the bin and may place the tape in a box to be sent to an off-site warehouse. In many cases, the media library is remotely located from the data backup system, and a user performing a backup may need to make special arrangements with the library administrator to be there to remove the tape from the bin. This can be especially problematic during typical backup periods, as they are often performed at night. Thus, a tape could be exported into the bin during a nighttime backup, and a morning library administrator would then see the tape in the bin the next morning, but not know what to do with it.

Thus, scheduling the tape for later export from when the tape is first identified for export may alleviate these problems. The claimed embodiments can act to schedule or stage tapes or other media to be exported. For example, the claimed embodiments enable a user of a data backup system to not only identify media to be exported, but also to schedule the export of the media, such as at a later time. Then, at the later time, the library administrator can go to the export bin and remove all media scheduled for export at that time. This prevents unnecessary travels to and from the export bin due to the immediate processing of media exports typical in other systems.

A.   The Answer Incorrectly Characterizes the Appellant's Invention

The Answer asserts that the "applicant's invention" is "a computer-implemented system and method...provided to export removable media in a storage device, according to a schedule" (Answer, page 7). The Answer apparently tries to summarize the appellant's entire invention by merely quoting the preamble of claim 1. By doing so, the Answer is not focused on the elements of the body of the claim, as is clearly revealed in the arguments regarding obviousness, discussed below. For example, claim 1 recites "a method of exporting removable media in a storage device according to a schedule," including "at a first time, receiving export identification data comprising first data identifying one or more removable media from the storage device to be exported

and second data identifying a second time at which the one or more removable media is scheduled to be exported."

The appellants' Specification provides an example of an implementation of the method of claim 1:

> A user specifies data representing media and a scheduled time for exports, step 30.... The input media and time data is stored in a data file, step 32. Until the scheduled time arrives, the user can continue to input additional data or modify the data already input. When the scheduled time arrives, step 34, a media list is obtained.... The admin system then generates a control signal to be sent to the library to export the media in the list, step 40. The signal is sent to the library, step 42, which then exports the media for removal and replacement, step 44. Specification at pages 6-7.

Claim 1 recites a method of identifying media for export from a library, including many elements, such as scheduling the export of the media from the library when the media is identified, and later exporting the media from the library. However, by only concentrating on the preamble, the Answer ignores the claim as a whole, and as a consequence, incorrectly applies prior art when providing arguments against the patentability of the claim.

B.   The Answer Incorrectly Asserts that the Appellants Attack the References in a Piecemeal Fashion

The Answer asserts that "it appears as if the appellant is attacking the references in a piecemeal fashion, instead of in combination, as intended by the Examiner..." (Answer, page 7). The appellants respectfully disagree. For example, section VII (B) of the appellants' Appeal Brief is entitled "The Combination of Crouse and Baca Do Not Teach or Suggest all the Claim Limitations," and provides discussion pointing out how neither reference

discloses certain elements of the claims.[1] The appellants have in fact considered *both* references and provided arguments attacking the *combination* of references, and thus do not understand the foundation for the Answer's assertion. In sum, the appellants have not provided arguments in a piecemeal fashion, and disagree with this assertion in the Answer.

C.   The Answer Incorrectly Asserts that the Cited References Disclose Each and Every Element of the Claims

The Answer equates "mount" and unload" to "import" and "export," respectively, which is clearly incorrect. Mounting removable media (e.g. a tape) to a secondary storage device (e.g., a tape drive) means loading a tape into a drive of a library and, likewise, unloading the tape from the secondary storage device means removing the tape from that drive.   Importing a tape into a library and later exporting the tape from the library refer, respectively, to bringing a tape into the library or removing the tape from the library. Indeed, before any tape can be mounted (to a drive), the tape must first be imported into the library. Clearly, unloading media (e.g. tape) from a drive is different than exporting media from a library.

The Answer further asserts that a "removable media reserved file 194" of Crouse "is deemed to store the claimed export identification data." The appellants respectfully disagree. The "removable media reserved file" contains information that enables the system of Crouse to access information on removable media. This is different than the "export identification data" recited in the claims, which is used for exporting media from a storage library.

For example, Crouse's removable media reserved file "allows remote files 42 stored on removable media to be truly considered as an integral part of the file tree structure 44" (Crouse, 19:37-39). This reserved file of Crouse "contains access information that identifies a specific entity of removable media 49" (Crouse, 19: 43-45), and "provide[s] the necessary information to facilitate

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[1] In fact, the Examiner misquotes the appellants on page 7, paragraph 2 of the Answer by condensing three pages of arguments into one paragraph, and then stating that the appellants "mainly argued" only the misquoted paragraph.

mounting of the removable media 49 on a secondary storage device 48 that can access the removable media 48" (Crouse, 19: 55-58). However, Crouse does not disclose any information stored in the removable media reserved file related to *importing* or *exporting* media in and out of a media library.

In addition, the Answer asserts that "the mount and unload commands to import or export the specific removable storage media is through the scheduling set by an Automatic Media loader module which definitely read on the claimed exporting removable media utility" (Answer, page 8). The appellants respectfully disagree. The automatic media loader module 190 of Crouse provides an "unload command...to free up a secondary storage 49" but does not provide any commands related to exporting media from a storage library. Furthermore, Crouse's loader module does not schedule the exporting of media when the media is first identified to be exported, and then later export the media.

In sum, the appellants disagree with the Answer's assertions that the references, *in combination*, teach each and every element of the claimed embodiments, for at least the reasons stated above.

D.   The Answer Incorrectly Asserts that One of Ordinary Skill in the Art Would Combine the Crouse and Baca References

The Answer asserts that:

> One of ordinary skill in the art at the time the invention was made would in fact, contrary to applicant's arguments, looking to incorporate the selective import/export interface as taught by Baca into the Crouse's system for the purpose to reveals more detail operations of the combined system that removes storage media by using the job scheduling corresponding to the input ordering commands for subsequently exporting removable storage media and execute these operations in a timely basis [sic]" Answer at page 9.

The appellants respectfully suggest that there may be one or more typographical errors in the previously cited paragraph, and due to these errors, the appellants have not been able to fully comprehend the exact arguments in this portion of the Answer. However, the appellants believe the Answer here asserts that the references are combined to provide for a more "timely" executed system. The appellants disagree that the references would be combined.

Crouse seeks to provide systems that automatically store and access remote files stored across data networks, including accessing files located on removable media. Baca, on the other hand, discloses the use of portable magazines to assist in transferring groups of portable media (via the magazines) from one library to another. The appellants contend that one or ordinary skill would not use the disclosure of Baca to solve problems in Crouse, because the portable magazine system of Baca would not assist in storing and accessing files across data networks, and certainly would not do so to export removable storage media and execute these operations on a "timely basis," as the Answer asserts.

Furthermore, appellants respectfully submit that the previous Office Actions and the Answer have not identified a proper motivation as to why a person of ordinary skill in the art would combine the Crouse and Baca references. The Office Actions and Answer simply assert that one of ordinary skill would incorporate the portable magazines of Baca into the data network system of Crouse "to reveals [sic] more detail operations of the combined system...and execute these operations in a timely basis" (Action, page 9). Such reasoning is merely a conclusion (and, an incorrect one) and does not satisfy the recent guidelines.

In light of the recent Supreme Court decision in *KSR vs. Teleflex*, the U.S. Patent Office has issued examination guidelines. *KSR vs. Teleflex* instructs that "one of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims." Crouse and Baca disclose neither the problems addressed in the appellants' Specification nor the

solutions encompassed by the claims, and are therefore an improper combination of references.

The appellants' claimed embodiments, for example, attempt to solve the problem of "a delay in exporting media" when a "library may be physically remote from [an] administrator performing a backup" (Specification, page 2). On the other hand, Crouse discloses problems with "the long-term storage and retrieval of large volumes of data" in "standard file systems" (Crouse, 4: 7-10) and does not disclose the export of media from a media library. Baca notes the problem that "an input/output station for single groups of cartridges may be highly inefficient..." (Baca 1: 55-56), and provides a solution by grouping media for exportation within portable magazines. Individually, neither reference attempts to solve problems addressed by the appellants' claimed embodiments. Therefore, even if combined, Crouse and Baca do not disclose the problems associated with the timing of exporting media in and out of a media library, much less provide any disclosed solutions that would render the claimed embodiments obvious.
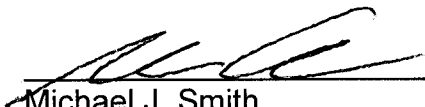
Conclusion

The Answer improperly rejects claims 1-20 because the Answer fails to establish a *prima facie* case of obviousness. More specifically, the Answer (a) fails to provide prior art references that disclose all the features of the claims, and (b) fails to provide a teaching or motivation to modify the references or combine reference teachings. Accordingly, the Appellants respectfully request that the Board reverse the rejection of the pending claims.

Respectfully submitted,

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